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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Anders Stokki

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EXAMINER

NGUYEN, KHANH TUAN

ART UNIT

PAPER NUMBER

1796

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/596,261	<b>Applicant(s)</b> STOKKI ET AL.	
	<b>Examiner</b> KHANH T. NGUYEN	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09/19/2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 12, 15-19, 21 and 23-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12, 15-19, 21 and 23-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>n/a</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Amendment***

1. The amendment filed on 09/19/2008 is entered and acknowledged by the Examiner. Claims 12, 15-19, 21, and 23-26 are currently pending in the instant application. Claims 1-11, 13-14, 20, and 22 have been canceled.

### ***Withdrawn Objection/Rejection***

2. The rejection of claims 12, 15-18, 20 and 23-25 under 35 U.S.C. 103(a) as being unpatentable over U.S Pat. 5,516,546 (Hari) in view of JP 62-291362 (Kojimoto) is withdrawn in view of Applicant's amendment and/or cancellation. The rejection of claim 19 under 35 U.S.C. 103(a) as being unpatentable over U.S Pat. 5,516,546 (Hari) in view of JP 62-291362 (Kojimoto) and further in view of either U.S. Pat. 5,120,811 (Glottfelter) or U.S. Pub. 2005/0227104 A1 (Kim) is withdrawn in view of Applicant's remark. The rejection of claims 21 and 26 under 35 U.S.C. 103(a) as being unpatentable over U.S Pat. 5,516,546 (Hari) in view of JP 62-291362 (Kojimoto) and further in view of U.S. Pat. 4,101,689 (Wienand) is withdrawn in view of Applicant's remark.

### ***Claim Rejections - 35 USC § 103***

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3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 12, 15-18 and 23-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. 5,516,546 (Hari) in view of U.S. Pat. 2003/0113566 A1 (Clemens) and further in view of U.S. Pat. 5,626,948 (Ferber).

With respect to claims 12 and 25, Hari teaches a conductive floor coating comprising of a substrate (3, 4, and non-label strip) and a conductive topcoat 5 (Fig. 3). At column 8 lines 32-57, Hari teaches a conductive lacquer layer consisting of a binder with or without solvent and conductive filler. The said conductive lacquer layer is position beneath, thus is considered to be a substrate, and the conductive coating composition is applied to the said lacquer in a thickness of 0.2-5 mm (i.e. 200-5000  $\mu\text{m}$ ). Hari further teaches the said conductive coating composition comprising of a binder such as epoxies, polyurethanes, polyesters or a mixture thereof (Col. 2, lines 9-11 and Col. 4, lines 22-33). Polyurethane is known in the art to be a transparent polymer. In order to provide conductivity, Hari suggest adding conductive filler such as carbon black, graphite or surface-treated metal powder to the coating (Col. 2, lines 11-13). Hari further teaches the metal fillers are likely used together with graphite (Col. 6, lines 37-39). Hari teaches the said conductive filler preferably having a particle size ranging from 20-1000  $\mu\text{m}$  (Abstract). The lower limit of 20  $\mu\text{m}$  overlaps with the claimed mean size of 0.1- 50  $\mu\text{m}$ . Hari also teaches the conductive filler particles is presented in an

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amount of 10-40% by weight of graphite, 5-30% weight of carbon fiber, or 1-10% weight finely divided metal particles (Col. 2, line 63 to Col. 3, line 8).

The differences between the instant application and Hari disclosure is that Hari is silent with respect to a conductive filler being a substantially spherical glass particles with a conductive coating comprising of silver, aluminum, copper, nickel, gold, or alloy thereof with another metal.

In analogous art, Clemens teach a coating composition used in floor surface covering ([0071], [0081], [0090], and [0093]). The said coating comprises of a topcoat and a basecoat (Fig. 1). Clemens teach the topcoat containing a transparent polymer as suggested by Hari [0115]. Clemens further teach the topcoat may include an electrically conductive material such as carbon black as suggested by Hari or silver coated glass spheres to dissipate static charge build-up [0077].

Furthermore, Ferber teaches a topcoat comprising of a polymer as suggested by Hari and Clemens (Col. 7, line 55 to Col. 8, line 4). In one embodiment, Ferber teaches a topcoat containing conductive material such as silver coated glass spheres will have little affect on the appearance of the of the multilayers whereas graphite and carbon black are less desirable for topcoat composition (Col. 9, lines 28-49). Ferber also teaches adding a small quantity of said silver coated glass sphere to obtain the desirable conductivity and color of the topcoat (Col. 9, lines 45-48).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the floor covering of Hari in view of Clemens and Ferber by substituting the carbon black or graphite filler of Hari with a silver coated

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glass sphere of Clemens in order to provide conductivity to dissipate static charge build-up in the topcoat as suggested by Clemens while maintaining the natural transparent appearance in the topcoat as opposed to using graphite or carbon black which will have a negative affect on the appearance of the multilayers as suggested by Ferber.

Further, the amended claims 12 and 25 including the “consisting essentially of” language is noted by the Examiner. The “consisting essentially of” language does not necessarily exclude the presence of unrecited elements because “consisting essentially of” renders the composition open to the inclusion of unspecified ingredients which do not materially affect the basic and novel characteristics of the composition, see *Ex parte Davis et al.* (Bd of Appeals), 80 USPQ 448. Applicants have not submitted factual evidence showing that the particle with a conductive coating consisting essentially of between 0.1 and 10 wt. % materially affects the instant invention. Moreover, Ferber teaches the same or substantially similar particle (i.e. silver coated glass sphere) as claimed and Hari teaches a conductive particle in a range that overlaps with the claimed range, thus it would have been obvious to one of ordinary skill in the art to arrived a the claimed floor surface covering composition at the time the invention was made.

Regarding claim 15, Kojimoto teaches a silver glass bead (Page 4). The court has held that structurally similar compound (i.e. the silver glass bead of Kojimoto) is generally expected to have similar properties (dry bulk resistivity ranging from 0.0001 and 0.01 Ohms/cm). In re Gvurik, 596 F. 2d 1012,201 USPQ 552.

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Regarding claims 16, 17, and 23, Hari teaches a polyurethane and methacrylate resin (i.e. an epoxy acrylate) (Col. 2, lines 9-13 and Col. 3, lines 39-50).

Regarding claims 18 and 24, Hari teaches the sum of the conductive fillers is less than 50% by weight (Col. 5, lines 45-50), which means that when floor coating is dried and the solvents have been evaporated the dry content of binders mixture such as epoxy(methyl)acrylate and polyurethane resin (Col. 4, lines 22-33) and may be greater than 50% by weight.

Regarding claim 20, Hari teaches a conductive substrate (i.e. conductive lacquer layer) (Col. 8 lines, 32-35). Kojimoto teaches the static electricity build up is dissipated in base surface (Last Paragraph, Page 3).

5. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. 5,516,546 (Hari) in view of U.S. Pat. 2003/0113566 A1 (Clemens) and U.S. Pat. 5,626,948 (Ferber) as applied to the above claims, and further in view of either U.S. Pat. 5,120,811 (Glotfelter) or U.S. Pub. 2005/0227104 A1 (Kim).

Hari, Clemens, and Ferber are relied upon as set forth above. Hari teaches a method of for obtaining a thin coating of less than 5 mm to 0.2 mm, i.e., less than 5000  $\mu\text{m}$  to 200  $\mu\text{m}$  (Col. 4, lines 37-40 and Col. 8, lines 53-57). However, Hari, Clemens, and Ferber did not disclose a top coating having a thickness between 0.5 to 100  $\mu\text{m}$ .

Glotfelter generally teaches a transparent polymer/glass coating composition (top coating) which provides stain and gloss protection to a flooring substrate (Col. 1, lines 10-15; Col. 2, lines 42-44; and Col. 7, lines 20-30) may be coated at a thickness of 1-2 microns (Col. 7, lines 15-18).

Kim also teaches a top coating (i.e. top painting layer) may be applied onto a flooring substrate at a thickness of 10 to 20  $\mu\text{m}$  by using a roll coater [0051].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the floor covering of Hari in view of Clemens and Ferber by coating the floor substrate with the conductive floor coating composition of Hari in view of Clemens and Ferber at a thickness within the claimed range of 0.5 to 100  $\mu\text{m}$  because Glotfelter teaches the motivation to providing stain and gloss protection to a flooring substrate at said thickness and Kim teaches a method of coating the flooring substrate with a roll coater to obtain said thickness.

6. Claims 21 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. 5,516,546 (Hari) in view of U.S. Pat. 2003/0113566 A1 (Clemens) and U.S. Pat. 5,626,948 (Ferber) as applied to the above claims, and further in view of U.S. Pat. 4,101,689 (Wienand).

Hari and Kojimoto are relied upon as set forth above. With respect to instant claims 21 and 26, Hari and Kojimoto did not disclose a polyvinyl chloride (PVC) substrate with vertical conductive channels.



At Fig. 6, Wienand teaches a polyvinyl chloride resin sheet (not labeled) coated with vertical conductive channels (not labeled). Hari teaches a ground conductor strip 3 position between the binder resin substrate 4 (Fig. 3). The grounded conductor strip 3 of Hari is considered to be a vertical conductive channel.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the floor covering of Hari in view of Clemens and Ferber by substituting the binder resin substrate 4 material of Hari with a PVC substrate having vertical conductive channel as suggested by Wienand to dissipate the electric static build up on the topcoat surface.

### ***Response to Arguments***

7. Applicant's arguments with respect to claims 12, 15-19, 21, and 23-26 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. pat. 4,218,507 (Deffeyes) and U.S. pat. 4,310,581 (Felter) teaches a floor covering material containing silver coated glass.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to KHANH T. NGUYEN whose telephone number is (571)272-8082. The examiner can normally be reached on Monday-Friday 8:00-5:00 EST PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/KTN/  
11/13/2008

/DOUGLAS MC GINTY/  
Primary Examiner, Art Unit 1796